

REMARKS

Claims 1-20 are pending in the present application. Claims 1, 16 and 19 are independent claims.

35 U.S.C. 103

Claims 1, 2, 6, 8, 9, 11, 13-15 and 16-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mogenis in view of Dockes and Maes. Applicants respectfully traverse this art grounds of rejection.

References Not Combinable

Applicants direct the Examiner's attention to two cases decided by the Court of Appeals for the Federal Circuit (CAFC), *In re Dembiczak*, 50 USPQ2d 1614 (Fed.Cir. 1999) and *In re Kotzab*, 55 USPQ2d 1313 (Fed.Cir. 2000). Both of these cases set forth very rigorous requirements for establishing a prima facie case of obviousness under 35 U.S.C. §103(a).

To establish obviousness based on a combination of elements disclosed in the prior art, there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant. The motivation, suggestion or teaching may come explicitly from the statements in the prior art, the knowledge of one of ordinary skill art, or in some cases, the nature of the problem to be solved. See *Dembiczak* 50 USPQ2d at 1614. For example, in *Kotzab*, the CAFC held that even though various elements of the claimed invention were present (in two separate embodiments of the same prior art reference), there was no motivation to combine the elements from the separate embodiments, based on the teachings in the prior art.

In order to establish a prima facie case of obviousness under 35 U.S.C. §103(a), the Examiner must provide particular findings as to why the two pieces of prior art are combinable. See *Dembiczak* 50 USPQ2d at 1617. Broad

conclusive statements standing alone are not "evidence". The Examiner alleges that it would be reasonable to combine Mogenis with Dockes and Maes. However, the Examiner has provided no justification for combining Mogenis with Maes and/or Mogenis with Dockes. Mogenis discloses a 911 real time information communication. Mogenis deals exclusively with emergency response systems. Dockes relates to a system and method for production of compact discs on demand. Maes discloses a portable information and transaction processing system and method utilizing biometric authorization and digital certificate security. The Examiner states that "it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the features of Maes and Mogenis to arrive at a system of storing an audio file with a record in a database since a record can contain a variety of types of information" (Page 4 of the Office Action). The Examiner further states "[i]t would have been obvious to one of ordinary skill in the art to combine the systems of Mogenis and Dockes since both are concerned with storing audio files in a relational database" (Page 5 of the Office Action).

Applicant submits that the reasoning to combine Mogenis with Dockes and/or Mogenis with Maes is insufficient. Further, the above motivation appears on its face to be broad and conclusory, lacking specificity, and silent regarding the evidence required to combine Mogenis with Dockes and/or Mogenis with Maes.

As such, claims 1, 2, 6, 8, 9, 11, 13-15 and 16-20 are allowable over Mogenis in view of Dockes and Maes, at least for the reasons given above. Applicants respectfully request that the Examiner withdraw this rejection.

**Technical Distinctions over Mogenis, Dockes and Maes**

The Examiner alleges "it is inherent that Mogenis' system stores the audio information on some form of recording media though it is not explicitly

stated” as recited on page 3 of the Office Action. The Examiner then uses Dockes as disclosing a means of storing the audio file on a recording media.

Initially, Applicants note that an assertion of inherency in a 35 U.S.C. 103 rejection is improper. Asserting inherency in a 35 U.S.C. 103 rejection implies that there is a difference between the art being applied and the instant claim. That difference requires that the Examiner supply an additional reference.

Further, Applicants submit that it is not inherent that Mogenis’ system stores the audio information on some form of recording media.

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)(reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art).

In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)(citations omitted)(The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.).

"To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) (The court went on to explain that "this modest flexibility in the rule that 'anticipation' requires that every element of the claims appear in a single reference accommodates situations in which the common knowledge of technologists is not recorded in the reference; that is, where technological facts are known to those in the field of the invention, albeit not known to judges." 948 F.2d at 1268, 20 USPQ at 1749-50.)

Note that "as long as there is evidence of record establishing inherency, failure of those skilled in the art to contemporaneously recognize an inherent property, function or ingredient of a prior art reference does not preclude a finding of anticipation. Atlas Powder Co. v. IRECO, Inc., 190 F.3d 1342, 1349, 51 USPQ2d 1943, 1948 (Fed. Cir. 1999)(Two prior art references disclosed blasting compositions containing water-in-oil emulsions with identical ingredients to those claimed, in overlapping ranges with the claimed composition. The only element of the claims arguably not present in the prior art compositions was "sufficient aeration . . . entrapped to enhance sensitivity to a substantial degree." The Federal Circuit found that the emulsions described in both references would inevitably and inherently have "sufficient aeration" to sensitize the compound in the claimed ranges based on the evidence of record (including test data and expert testimony). This finding of inherency was not defeated by the fact that one of the references taught away from air entrapment or purposeful aeration.).

Mogenis states "the audio and/or video information produced at the customer premises 12 of Fig. 1 and coupled over signal path 30 to the Security

Center 14 is processed by the controller 38 in a fashion which transmits audio and/or video information, as appropriate, over a network, illustrated as a security element network 16, to the responding unit illustrated as 18” (column 4, lines 17-23). Mogenis is silent on storing this audio and/or video information. Mogenis describes transmitting audio and/or video information over a network, not storing audio and/or video information. Specifically, Mogenis is silent on “storing the audio file on a recording media” and then “linking the audio file to the record” as recited in independent claim 1. Mogenis is similarly deficient in disclosing the features described above within independent claims 16 and 19.

Applicants respectfully request the Examiner withdraw this art grounds of rejection.

35 U.S.C. 103 Mogenis in view of Dockes and Maes and Further in view of DeMartin

Claims 3 and 4 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mogenis in view of Dockes, Maes and DeMartin. Applicants respectfully traverse this art grounds of rejection.

The Applicants agree with the Examiner in that “Dockes does not disclose storing the audio file in an analog format on an analog recording media” as recited on page 7 of the Office Action. However, even if DeMartin would teach this particular feature, DeMartin is insufficient in overcoming the deficiencies of Mogenis in view of Dockes and Maes with respect to independent claim 1. As such, claim 3, dependent upon independent claim 1, is allowable over Mogenis in view of Dockes in view of Maes and further in view of DeMartin at least for the reasons given above with respect to independent claim 1. Applicants respectfully request that the Examiner withdraw this art grounds of rejection.

Applicants again agree with the Examiner in that “Dockes does not disclose storing the audio file in an analog format on an analog recording media” as recited on page 7 of the Office Action. However, even if DeMartin were to teach this one particular feature, DeMartin is clearly insufficient in overcoming the deficiencies of Mogenis in view of Dockes and Maes in rendering claim 1 as obvious. As such, claim 4, dependent upon independent claim 1, is allowable over Mogenis in view of Dockes and Maes and further in view of DeMartin at least for reasons given above with respect to independent claim 1. Applicants respectfully request that the Examiner withdraw this art grounds of rejection.

35 U.S.C. 103(a) Mogenis in view of Dockes and Maes and further in view  
of Kelly

Claims 5 and 10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mogenis in view Dockes and Maes and further in view of Kelly. Applicants respectfully request that the Examiner withdraw this art grounds of rejection.

Kelly is clearly insufficient in overcoming the deficiency of Mogenis in view of Dockes and Maes as discussed above with respect to independent claim 1. As such, claims 5 and 10, dependent upon independent claim 1, are likewise allowable over Mogenis in view of Dockes and Maes and further in view of Kelly at least for the reasons given above with respect to independent claim 1. Applicants respectfully request that the Examiner withdraw this art grounds of rejection.

35 U.S.C. 103(a) Mogenis in view of Dockes and Maes and further in view  
of Akagiri

Claims 7 and 12 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Mogenis in view of Dockes and Maes and further in view of Akagiri. Applicants respectfully traverse this art grounds of rejection.

Akagiri discloses compressed digital data recording and reproducing apparatus with selective block deletion. Akagiri is clearly insufficient in overcoming the deficiencies of Mogenis in view of Dockes and Maes with respect to independent claim 1. As such, claims 7 and 12, dependent upon independent claim 1, are likewise allowable over Mogenis in view of Dockes and Maes and further in view of Akagiri at least for the reasons given above with respect to independent claim 1. Applicants respectfully request that the Examiner withdraw this art grounds of rejection.

CONCLUSION

In the event that any matters remain at issue in the application, the Examiner is invited to contact the undersigned at (703) 668-8000 in the Northern Virginia area, for the purpose of a telephonic interview.

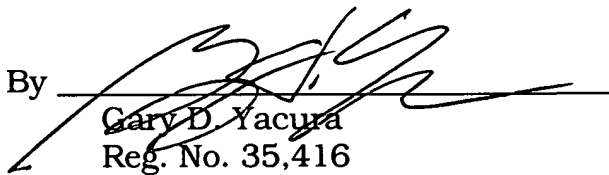
U.S. Appln. No. 09/315,621  
Attorney Docket No. 29250-000881/US

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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